

**REMARKS**

Claims 1 and 4-22 are pending in the application, claims 1, 4-5, 8-12 and 15-20 are rejected, claims 6-7 and 13-14 are objected to as being dependent from a rejected base claim, and claims 21 and 22 are allowed. With this response claims 1 and 4-22 are amended. All amendments are fully supported by the specification as originally filed.

Claims 1, 4-15 and 21-22 are amended to remove reference numerals, which does not have any affect on the scope of the claims. See MPEP § 608.01(m). Claims 1, 4, 6-22 are amended to remove “characterized.” Claim 20 is amended to correct an informality. These amendments have no affect on the scope of the claims amended, and are made to place the claims in better form. Therefore, no new search is required as a result of these amendments, and applicant respectfully requests that these amendments be entered.

Claims 17 and 20 are amended in response to the newly presented rejection under § 112, first paragraph. Claims 17 and 20 are amended to include limitations similar to those recited in claim 1, in order to clarify what is meant by “a member applying a force in a second angular direction opposite to the first angular direction.” On page 3 of the final Office Action the Office had interpreted this limitation the same as the limitations from claim 1 when preparing the final Office Action. Therefore, since the Office has already interpreted the newly added portions of claims 17 and 20 to mean what they currently recite no new search is required. Furthermore, the amendments could not have been presented earlier because the sections of the specification identified in the previous response supported the previous amendments to claims 17 and 20, and therefore it was not believed that any additional language was required in claims 17 and 20 at that time. In addition, the preambles of the claims 17 and 20 are removed and incorporated into the body of the claims in order to avoid redundancy, and place the claims in better form. As such, applicant respectfully requests that the amendments to claims 17 and 20 be entered.

**Claim Objections**

Claim 20 is amended to replace “;” with “,” in order to correct the informality objected to by the Office.

**Claim Rejections Under § 112**

At section 3, on page 2 of the final Office Action, claims 17-20 are rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Claims 17 and 20 are amended to include limitations similar to those recited in claim 1. Support for these amendments can be found at least at page 5, lines 11; page 10, line 20—page 11, line 3; page 11, lines 10-23; and page 12, lines 9-26. In particular, page 10, lines 28-32 state, “the angular disposition of the weight elements 12A, 12B can be continually adjusted to and maintained on a desired level by controlling the rotating power of the electric motors so that a difference in rotating forces equal to the torsion force at the desired angular disposition of the weight elements.” At least this passage, and the sections mentioned above, would convey to one of skill in the art that applicant was in possession of the invention recited in claims 17 and 20 at the time the application was filed. See MPEP § 2163.02 (The subject matter of the claim need not be described literally, i.e. using the same terms, in order for the disclosure to satisfy the description requirement). Therefore, applicant respectfully requests withdrawal of the rejection to claims 17-20.

**Claim Rejections Under § 103**

At section 5, on page 3 of the final Office Action, claims 1, 4-5, 8-12 and 15 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hayes, Jr. (U.S. Patent No. 6,002,927). Applicant respectfully submits that Hayes fails to at least disclose or suggest a member for forming a force that tries to change an adjusted angular disposition of the weight elements in a second angular direction opposite to a first angular direction in order to maintain an offset  $r$  on a desired level within a predetermined range, as recited in claim 1.

Office recognizes on page 4 that Hayes does not disclose or suggest that the offset can be maintained on a desired level within a predetermined range, as recited in claim 1. The Office asserts that it would be obvious to maintain the offset within a predetermined range based on the teachings of Hayes. However, applicant respectfully submits that claim 1 is not obvious in light of Hayes for at least the following reasons.

First, the Office states that “one skilled in the art” would recognize that maintaining the offset within a predetermined range would be obvious. However, it is improper to rely upon the level of skill in the art to provide the motivation to modify a reference in order to

assert that claimed subject matter is obvious. See MPEP § 2143.01. The Office has merely asserted that it would be within the ordinary skill of the art to modify Hayes to arrive at the invention recited in claim 1. Therefore, the assertion that claim 1 would be obvious based on the teachings of Hayes is improper, because the level of skill in the art cannot be relied upon to provide the motivation to modify a reference.

Second, the arrangement disclosed by Hayes has exactly two positions in which the eccentric weights 90, 92 can be maintained, the first position of Figure 2 with a first offset R1, and the second position of Figure 3 with a second offset R2. Therefore, the second offset R2 associated with the second position of Figure 3 represents a minimum level for the offset range disclosed by Hayes. Correspondingly, the first offset R1 associated with the first position of Figure 2 represents a maximum level for the offset range disclosed by Hayes. However, Hayes fails to teach or suggest that the offset can be maintained on a desired level within the offset range R2-to-R1, as recited in claim 1. Instead, Hayes merely discloses maintaining the offset either at its minimum level or its maximum level. The tab 104 disclosed by Hayes allows for the offset to be either R1 or R2, depending on the rotational direction of the shaft 94. In order to arrive at the invention claimed in claim 1 an additional feature would have to be added to the arrangement disclosed by Hayes. Namely a member that forms a force that allows for the maintenance of the offset on a desired level within a predetermined range. Since Hayes fails to disclose or suggest such an item, claim 1 is not obvious in view of Hayes, and applicant respectfully submits that the Office has only arrived at the invention of claim 1 through the use of impermissible hindsight reasoning. See MPEP § 2143. Therefore, for at least the reasons discussed above, claim 1 is patentable over Hayes, and applicant respectfully requests withdrawal of the rejection to claim 1.

Dependent claims 4-5, 8-12 and 5 depend directly or indirectly from independent claim 1, and are patentable over the cited references at least in view of their dependencies. Therefore, applicant respectfully requests withdrawal of the rejections to these claims.

At section 6, on page 5 of the Office Action claims 16-20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hayes in view of Uriya (U.S. Patent 6,574,489). Independent claims 17 and 20 are amended to include limitations similar to those recited in independent claim 1. Therefore, for at least the reasons discussed above in relation to claim 1, and

because Hayes and Uriya, alone or in combination, also fail to disclose or suggest forming a force by a member that tries to change the angular disposition of the weight unit in a second angular direction opposite to the first angular direction in order to maintain the offset  $r$  on said desired level within said predetermined range, claims 17 and 20 are not disclosed or suggested by the cited references. As such, applicant respectfully requests withdrawal of the rejections to these claims.

Claim 16 ultimately depends from independent claim 1, and is patentable over the cited references at least in view of its dependencies. Claims 18 and 19 ultimately depend from independent claim 17, and are patentable over the cited references at least in view of their dependencies. As such, applicant respectfully requests withdrawal of the rejections to these claims.

#### **Allowable Subject Matter**

Claims 6, 7 and 13-14 are objected to as being dependent upon a rejected base claim, but are indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 6, 7 and 13-14 ultimately depend from an independent claim, and are patentable over the cited references at least in view of their dependencies. Therefore, applicant does not wish to place these claims in independent form at this time.

Applicant acknowledges that claim 21-22 are allowed, and believes that the claims are allowable for at least the reasons discussed in the Office Action on page 7.

#### **Conclusion**

The rejections of the Office Action having been obviated by amendment or shown to be inapplicable, withdrawal thereof is requested, and passage to issue of the present application is earnestly solicited. The undersigned believes that no additional fee is required

to submit this response, but hereby authorizes the Commission to charge deposit account 23-0442 for any fee deficiency required to submit this response.

Respectfully submitted,



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